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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/833,026	04/10/2001	Gary Helms	108298613US	8349
25096	7590	07/28/2006	EXAMINER	
PERKINS COIE LLP			WEBB, JAMISUE A	
PATENT-SEA				
P.O. BOX 1247			ART UNIT	
SEATTLE, WA 98111-1247			PAPER NUMBER	
			3629	

DATE MAILED: 07/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/833,026	Applicant(s) HELMS ET AL.	
	Examiner Jamisue A. Webb	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 and 21-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 21-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/5/06 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-19 and 21-36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicant has added the limitation "the existing order database being unable to track information at the level of individual units of items of an order", which is considered to be new matter. The specification seems to point out that the order database does not track information at the unit level, however new contains the negative limitation that it is "unable" or incapable of tracking at the unit level. Even though it states that it does not do it, is not sufficient evidence that the order database is "unable" to do it.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-19 and 21-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. With respect to Claims 1, 11, 22, 32 and 36: the phrase “creating a unit order database using information from the existing order database” is unclear. The claims previously state that the existing order database being unable to track information at the level of individual units of items of an order, therefore how can it use information that the existing order data is unable to provide?

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1-3, 9, 12, 17-19, 22-24, 28-30, and 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kipp (5,890,136) in view of Horwitz et al. (6,496,806).

10. With respect to Claims 1, 11, 22, 32 and 36: Kipp discloses the use of an order database (26) that is used to pull inventory and for shipping (See abstract), where the orders are tracked (Column 2, lines 34-37) through an order database (Column 7, lines 16-18) and tracks the articles (Column 5, lines 47-64). However, Kipp fails to disclose the use of a unit order database that includes a record for each unit of each item of the order. Horwitz discloses the use of a method and system for tracking each individual item of a cluster of items (See abstract) that can be used for purchase order systems (Column 1, lines 17-63), where a record of each item is stored in a database, and each record is linked through a cluster, so that when the status of one item changes, the cluster changes (see Column 4, lines 40-57, Column 1, lines 1-20, and Column 8, lines 17-24). Each time the clusters are broken up and then regrouped essentially a new database is being created. A database is considered to be merely a collection of data that is organized. Therefore when the clusters are regrouped the records are reorganized and a new database is formed. The cluster ID is associated with each individual unit, therefore information from the larger database is used for each unit. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kipp, to include the method and system of tracking each individual item of a cluster, as disclosed by Horwitz, in order to more accurately track items that are moved, handled or processed in clusters. (See Horwitz, Column 1)

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11. Kipp and Horwitz discloses the use of individual units of an order being tracked separately, and when each individual record of the unit changes, then the cluster (or order) would change. The combination of Kipp and Horwitz fails to disclose the unit order database and order database be separate databases.

12. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have the unit order database and order database be separate databases because Applicant has not disclosed that have separate databases provides an advantage or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the centralized database taught by Horwitz because both methods perform the same function of tracking items on a unit level, and updating on an individual basis.

13. Therefore, it would have been an obvious matter of design choice to modify Kipp and Horwitz to have the centralized database, be two separate databases.

14. With respect to Claims 2, 12, 23, 33 and 36: See Horwitz, Column 6, lines 9-19.

15. With respect to Claims 3, 13, 24 and 34: See Horwitz, Column 6, lines 28-50.

16. With respect to Claims 7, 17 and 28: Horwitz discloses the updating of the database that contains the items happens when the items are moved from one storage location to another storage location (See Column 11, line 41 to Column 12, line 64). The examiner considers this to be a periodic basis, since the pallets are not moved on a continuous basis, but sit in storage and inventory.

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17. With respect to Claims 8, 18 and 29: The items in Horwitz are tracked on a real time basis (column 12, lines 65), therefore multiple times a day, which the examiner considers to be done on a daily basis.

18. With respect to Claims 9, 19 and 30: See Column 12, lines 1-67.

19. Claims 4-6, 10, 13-16, 21, 25-27, 31 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kipp and Horwitz et al. as applied to claims 1, 11, 22 and 32 above, and further in view of Peachey-Kountz et al. (6,463,345).

20. With respect to Claims 4-6, 10, 13-16, 21, 25-27, 31 and 35: Kipp and Horwitz discloses the use of a purchase order and having a record for each item in an order that is shipped, but fail to disclose the order can be modified to increase or decrease the quantity of the order, and either adding a unit record or setting a record to cancelled. Peachey-Kountz discloses the use of orders where the quantity of items are changed and modified due to backorders or cancellation of orders (see Figures 5-7, Column 11, lines 53-67), and the record status is updated to reflect the change, (see Figures 5 and 6 with corresponding detailed description). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kipp and Horwitz, to include the capability of changing the order, and the records reflecting the change, in order to provide an improved reporting system. (See Peachey-Kountz, Column 9)

Response to Arguments

21. With respect to Applicant's argument that the specification supports the added limitation of "unable to track information at the level of individual units of items of an order" is supported

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by the specification. As stated above in the 112 First paragraph new matter rejection, the examiner does not feel this information is sufficient to show support by the specification, particularly the word “unable”. This implies the order database is incapable of supplying this information. What if there is only one unit ordered, will it track information then? The term information is very broad, is it shipping information, historic information or status information? Therefore to say it is unable to track information severely limits database to not be able to track any kind of information, which the examiner feels is not supported by the specification.

22. With respect to Applicant’s arguments that by amending the claims to recite the limitation “creating a unit order database using information from the existing order database” overcomes the prior art of record: After further review and consideration of the amended claims, the examiner feels that the claims still reads on the prior art of record. The term “information” is a very broad term to where it can read on tracking the location of a unit. It does not specifically state what type of information is being tracked. Furthermore, the preamble is drawn to a method for tracking orders, it is not tracking a status of each individual unit of an order. Therefore by allowing the tracking to be tracking as in location in warehouse or through the shipping process, the claims still read on the prior art of record, as stated above.


23. The examiner invites the attorney to contact her for a further discussion on the claim amendment and the prior art rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamisue A. Webb whose telephone number is (571) 272-6811. The examiner can normally be reached on M-F (7:30 - 4:00).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Jamisue Webb
Patent Examiner
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